

Serial No.: 09/662,501

REMARKS

Claims 1-11 are pending in the application. Claims 2, 3, 6 and 10 are amended herein. The amendments are identical to the amendments previously submitted by applicants in their response to final office action filed on March 28, 2005, but not entered. Entry of the amendments and favorable reconsideration of the application is respectfully requested.

I. REQUEST FOR TELEPHONE INTERVIEW

Applicants respectfully request that the Examiner contact the undersigned to arrange for a telephone interview at a mutually convenient time prior to further action on the merits. In view of the approximately five year pendency of this application, applicants believe such a telephone interview will be helpful to expedite favorable prosecution.

II. RESPONSE TO ADVISORY ACTION

The amendments and remarks presented herein are based on those previously submitted in Applicants' response after final filed on March 28, 2005. The Examiner issued an Advisory Action on April 29, 2005. Applicants offer the following response thereto:

The Examiner indicates in the Advisory Action that applicants' amendments in their response filed March 28, 2005 would not be entered except for purposes of appeal. Regarding the rejections under 35 USC §112, first and second paragraph, the Examiner indicates that the arguments were persuasive and the rejections are withdrawn. Accordingly, for purposes of appeal, claims 2, 6 and 10 are allowed. Claim 4 is identified as being allowable if amended to independent form.

On the other hand, the Examiner indicates that claims 1, 3, 5, 7-9 and 11 remain rejected under 35 USC §102(b) based on Kato et al. Regarding claim 1, the Examiner indicates that applicants contend that Kato et al. does not discuss using a memory in a mode other than a print mode. However, the Examiner argues that according to the bottom of page 8 of the applicants' remarks, a PC mode is a mode other than a print

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mode. The Examiner thus concludes that the PC and scanner modes in Kato et al. use memory 19 and thus constitute plural modes in accordance with applicants' invention.

Applicants respectfully disagree with the Examiner's characterization that a PC mode constitutes an "other mode" as recited in claim 1. Specifically, claim 1 recites that "each of the other modes involve recording image information on a recording medium". A "PC mode" does not in any way denote a "mode involving recording image information on a recording medium" as recited in claim 1. The CCD scanner 16 and printer engine 18 in Kato et al., referred to by the Examiner, simply relate to the respective portions of the facsimile device. Again, therefore, there are no plural modes as suggested by the Examiner. Similar arguments apply with respect to claim 3.

Thus, prior to the Examiner possibly issuing another non-favorable Office Action, applicants again respectfully request the Examiner contact the undersigned in order to arrange a mutually convenient time to conduct a telephone interview. Applicants believe it will be helpful to provide a better understanding of the intended distinctions between the present invention and the cited art such as those discussed herein.

III. CLAIM AMENDMENTS

The Examiner has identified claims 2, 6 and 10 as representing allowable subject matter. Applicants have amended claims 2, 6 and 10 herein so as to be in independent form. Thus, claims 2, 6 and 10 should now be in condition for allowance.

Applicants have amended claim 3 to independent form and to include the features of dependent claim 11.

IV. REJECTION OF CLAIMS 1-11 UNDER 35 USC §112, 1ST & 2ND ¶¶

The Examiner previously rejected claims 1-11 under 35 USC §112, first and second paragraphs, as being indefinite. The Examiner also previously rejected claim 11 under 35 USC §112, first paragraph, as failing to comply with the enablement requirement.

Such rejections have now been withdrawn as noted in the Advisory Action.

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V. REJECTION OF CLAIMS 1, 3, 5, 7-9 AND 11 UNDER 35 USC §102(b)

Claims 1, 3, 5, 7-9 and 11 remain rejected under 35 USC §102(b) based on *Kato et al.* Applicants again respectfully traverse the rejection for at least the reasons discussed above in relation to the Advisory Action, and the following additional reasons.

Beginning on page 6 of the Office Action, the Examiner responds to the applicants' arguments set forth in their previous response. Notably, the Examiner does not rely on the teachings at column 10, lines 6-21 of *Kato et al.* as before when responding to the applicants' arguments. Rather, the Examiner now relies on column 7, lines 1-18 of *Kato et al.*

Specifically, the Examiner now argues that the facsimile machine 1 in *Kato et al.* initially stores the image data in the image memory 19. Thereafter, the Examiner argues that the facsimile machine 1 sends the image data stored in the image memory 19 to the printer 18 for printing on a page basis.

Initially, applicants point out that *Kato et al.* does not disclose that the printer engine 18 even includes a memory. Thus, it has not been shown in *Kato et al.* that there is a transfer of the image data stored in the memory 19 to a memory for an other mode as recited in claim 1. *Kato et al.* does not teach or suggest a memory in the printer engine 18.

Furthermore, the printer engine 18 in *Kato et al.* is provided only for facsimile reproduction. Therefore, to the extent the printer engine 18 may include a memory such as a buffer, such memory still does not represent a memory for an other mode as recited in claim 1.

Further still, based on the Examiner's reliance on column 7, lines 1-18 of *Kato et al.*, the Examiner may be referring to the buffer memory 12 as representing the memory for facsimile available only in the facsimile mode, and the image memory 19 as representing the claimed memory for the other modes. Even in this case, however, although the buffer 12 may be a memory for facsimile available only in the facsimile mode since unit 1 is only a facsimile, the memory 19 in such case still would not represent a memory for an other mode as recited in claim 1.

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Accordingly, the Examiner still has not shown that *Kato et al.* teaches or suggests each and every feature recited in claim 1.

Regarding claim 3, now in independent form, the Examiner rejects the claim based on *Kato et al.* teaching that when the residual storage capacity of the fax memory is determined to be below the predetermined level, data is sent to the PC side (see, e.g., Col. 10, Ins. 6-21). However, the data transfer to the external PC which is carried out in *Kato et al.* is different from the data transfer which is carried out between the memories in a stand-alone type apparatus as recited in claim 3.

Furthermore, claim 3 includes all of the features of claim 1. Consequently, claim 3 may be distinguished over *Kato et al.* based on the same reasons discussed above in relation to claim 1.

For at least the above reasons, withdrawal of the rejection of claims 1, 3 and the claims dependent therefrom is respectfully requested.

VI. CONCLUSION

Accordingly, all claims are believed to be allowable and the application is believed to be in condition for allowance. A prompt action to such end is earnestly solicited.

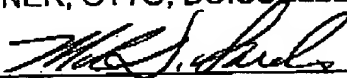
Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

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Should a petition for an extension of time be necessary for the timely reply to the outstanding Office Action (or if such a petition has been made and an additional extension is necessary), petition is hereby made and the Commissioner is authorized to charge any fees (including additional claim fees) to Deposit Account No. 18-0988.

Respectfully submitted,

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